

REMARKS

I. Status of the Application

Claims 1-20 are pending in this application. In the September 20, 2005 Office action, the examiner rejected claims 1-6 and 8-10 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. patent No. 6,008,711 to Bolam (“Bolam”) in view of U.S. Publication No. US 2002/0101167 to Shan et al. (“Shan”). The examiner also rejected claims 7 and 12 under 35 U.S.C. § 103(a) as allegedly being obvious over Bolam in view of Shan and further in view of U.S. patent No. 6,097,607 to Carroll et al. (“Carroll”). In addition, the examiner rejected claims 13-16 and 20 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. patent No. 3,652,936 to Burkhart Jr. (“Burkhart”) in view of U.S. patent No. 4,121,147 to Becker et al. (“Becker”). The examiner also rejected claims 17 and 18 under 35 U.S.C. § 103(a) as allegedly being obvious over Burkhart in view of Becker and further in view of Bolam, and rejected claim 19 under 35 U.S.C. § 103(a) as allegedly being obvious over Burkhart in view of Becker and further in view of Shan. Finally, the examiner alleged that claim 13 of the application is in conflict with claim 3 of Application No. 10/772,160, stating that claim 3 of such application is obvious variant or broadening of the scope of claim 13 of the present application.

In this response, applicants have traversed the examiner’s rejection of claims 1-20 under 35 U.S.C. § 103(a).

II. The Rejection of Independent Claims 1 and 8 should be Withdrawn

In the September 20, 2005 Office action, the examiner rejected claims 1 and 8

under 35 U.S.C. § 103(a) as being obvious and unpatentable over Bolam in view of Shan. Applicants respectfully traverse the examiner's rejection of claims 1 and 8 under 35 U.S.C. § 103(a), as the examiner has failed to make a *prima facie* case of obviousness as described in MPEP § 2142 - 2143.

A. All Claim Limitations Must Be Taught or Suggested

In order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

1. Bolam

Bolam discloses a current transformer assembly 22 including a current transformer 80 positioned within a wall member 82. As noted by the examiner in the September 30, 2005 office action, Bolam does not disclose an insulation cup comprising two parts, wherein the first part is configured to couple to the second part and encapsulate the current transformer.

2. Shan

Shan discloses a plasma reactor including an inductive power applicator 125 having a torroidal magnetic core 200 with multiple windings 205. The magnetic core 200 is enclosed between an upper torroidal housing 215 and a lower base 220 in order to protect the magnetic core 200 from the plasma and gasses in the chamber. (See paragraph [0030]). The upper housing 215 and the lower base 220 are formed of anodized aluminum. (See paragraph [0030]). Accordingly, Shan does not disclose a two-part insulation cup. In fact, Shan does not disclose an insulation enclosure of any form, as aluminum is a conductor of electricity and not an insulator.

As set forth above neither Bolam nor Shan disclose all limitations of applicant's

claims 1 or 8. For example, neither Bolam nor Shan disclose “an insulation cup comprising a first part and a second part, the first part configured to mechanically couple to the second part such that the first part and the second part substantially encapsulate the current transformer” as required in applicant’s claim 1. Additionally, neither Bolam nor Shan disclose “disposing a current transformer between a first part and a second part of an insulation enclosure,” as required in applicant’s claim 8. Because all limitations of applicant’s claims 1 and 8 are not disclosed in either Bolam or Shan, the examiner’s rejection of claims 1 and 8 under 35 U.S.C. § 103(a) should be withdrawn.

B. There Must Be a Basis in the Art for Combining the References

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the reference teachings. MPEP § 2143. A motivation to combine references is required to “prevent the use of hindsight based on the invention to defeat patentability of the invention.” See In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990).

In the September 20, 2005 Office action, the examiner provided the following argument as a motivation to combine Bolam and Shan: “[t]he motivation would have been to isolate the transformer from other electrical parts of the assembly.” However, contrary to the examiner’s position, the metal enclosure disclosed in Shan does not act to insulate the transformer from other electrical parts of the assembly. Instead, such a metal enclosure would actually encourage arcing. By combining the upper housing and base of Shan with the current transformer of Bolam, the intended function of the enclosure would

be destroyed. Thus, the examiner's stated motivation for combining the references is not consistent with the cited art. Accordingly, the examiner's rejection of claims 1 and 8 under 35 U.S.C. § 103(a) should be withdrawn.

C. The Prior Art Teaches Away

When the prior art teaches away from the claimed invention, there is a suggestion of a lack of *prima facie* obviousness. MPEP § 2145; See In re Fine, 873 F. 2d 1071 (Fed. Cir. 1988). In the present case, the examiner has combined Bolam and Shan. As discussed previously, Shan discloses an enclosure comprised of electrically conductive material. Use of such an electrically conductive material teaches away from the claimed invention, as each of claims 1 and 8 require an insulation enclosure. Accordingly, because the prior art teaches away from the claimed invention, it is respectfully submitted that the examiner has failed to make a *prima facie* case of obviousness, and the rejection of claims 1 and 8 under 35 U.S.C § 103(a) should be withdrawn.

D. Shan is Non-analogous Prior Art

In order to rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. MPEP § 2141.01(a). The determination that a reference is from a non-analogous art is twofold. First, it must be decided if the reference is within the field of the applicant's endeavor. Second, if it is not, it must be determined whether the reference is reasonably pertinent to the particular problem with which the applicant was involved. *Id.*; In re Wood, 599 F.2d 1032 (CCPA 1979).

First, Shan relates to semiconductor wafer etching. The present invention, on the other hand, relates to current transformers. Accordingly, the field of Shan is not within the field of the applicant's endeavor.

Second, Shan is not pertinent to the particular problem with which applicant was involved. Applicant's problem, as set forth in the background section of the application, involves electrical insulation of the current transformer. Conversely, Shan is concerned with a plasma reactor having a current transformer, wherein the current transformer is protected from plasma and gas in the chamber. Although both problems involve isolation of a current transformer, the problems are unrelated, as one problem involves electrical isolation, and the other problem involves isolation from plasma and gasses.

Accordingly, Shan is non-analogous art because it is neither within the field of applicant's endeavor nor pertinent to the particular problem with which applicant was involved. Because Shan is non-analogous prior art, it is respectfully submitted that the examiner has failed to make a *prima facie* case of obviousness, and the rejection of claims 1 and 8 should be withdrawn.

### III. The Rejection of Independent Claim 13 Should be Withdrawn

#### A. All Claim Limitations Must Be Taught or Suggested

As set forth previously, in order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

##### a. Burkhart

Burkhart discloses a current transformer 28 having a core 57 defining a void, and a first coil 26 and a second coil 28 passing through the void. As noted by the examiner in the September 30, 2005 office action, Burkhart does not disclose an insulation member disposed between the first coil and the second coil.

b. Becker

Becker discloses a watt-hour meter comprising a meter socket 10 comprising a bottom wall 13. A pair of spaced insulating blocks 18, 20 are secured to the bottom wall 13 of the meter socket 10.

In the September 30, 2005 Office action, the examiner states with respect to Becker that “the insulating blocks are secured to the bottom wall of the socket base by member 19a for receiving transformer 28.” The examiner cites column 4, lines 50-62 of Becker in support of this position. Applicant fails to see in Becker any mention of insulating blocks being received by transformer. There is specifically no mention of a transformer in the examiner’s cite to Becker. Furthermore, even if the examiner’s statement is correct, applicant fails to understand its relevance to claim 13, as Becker does not appear to disclose “an insulation member disposed between a first coil and a second coil” as set forth in claim 13.

As set forth above, neither Becker nor Burkhart disclose all limitations of applicant’s claim 13. For example, neither Becker nor Burkhart disclose “an insulation member disposed between the first current coil and the second current coil”, wherein the first current coil and second current coil pass through a void defined by a current transformer. Because all limitations of applicant’s claim 13 are not disclosed in either Burkhart or Becker, the examiner’s rejection of claim 13 under 35 U.S.C. § 103(a) should be withdrawn.

**B. There Must Be a Basis in the Art for Combining the References**

As set forth previously, in order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the reference teachings. MPEP

§ 2143.

In the September 20, 2005 Office action, the examiner provided the following argument as a motivation to Burkhart and Becker: “[t]he motivation would have been to insulate the coil components.” The motivation provided by the examiner is prohibited hindsight. There is no discussion in either Burkhart or Becker of the need for such insulation. Furthermore, contrary to the examiner’s position, there is no insulation member disposed between relevant coil components in Becker. Instead, Becker simply discloses insulation blocks positioned on a bottom wall of a meter socket, wherein meter components are positioned near the insulation blocks. As discussed above, neither Burkhart nor Becker, alone or in combination, teach or suggest all limitations of applicant’s claim 13. The combination of Burkhart and Becker simply would not suggest the claimed invention. Thus, the examiner’s stated motivation for combining the references is not consistent with the cited art. Accordingly, the examiner’s rejection of claim 13 under 35 U.S.C. § 103(a) should be withdrawn.

IV. The Rejection of Dependent Claims 2-7, 9-12 and 14-20 Should be Withdrawn

Dependent claims 2-7, 9-12 and 14-20 all depend from and incorporate all the limitations of one of allowable independent claims 1, 8 or 13. Moreover, each of these dependent claims includes additional novel and non-obvious limitations. Accordingly, it is respectfully submitted that dependent claims 2-7, 9-12 and 14-20 are also allowable for the same reasons that independent claims 1, 8 and 13 are allowable, as well as additional reasons.

V. The Examiner's Requirement to Cancel Claim 13 Should be Withdrawn

In the September 30, 2005 Office action, the examiner alleged that claim 13 of the application is in conflict with claim 3 of Application No. 10/772,160 (the “‘160 Application”), alleging claim 3 of such application is obvious variant or broadening the scope of present claim. Applicant fails to see that claim 13 of the present application is an obvious variant of claim 3 of Application No. 10/772,160. Claim 13 of the present application is directed to an arrangement including a current transformer, two current coils passing through a void in the current transformer, and an insulation member disposed between the first current coil and the second current coil. By contrast, claim 13 of the ‘160 Application is directed to a current coil arrangement including two coils having a particular unique configuration, such coils passing through a void in a current transformer. The limitations between the claims are entirely different, and there is no reason why the particular arrangement claimed in the ‘160 Application should be considered an obvious variation of the arrangement of claim 13 in the present application. Accordingly, the examiner’s statements concerning claim 13 of the present application and claim 3 of the ‘160 Application should either be withdrawn. If the examiner’s statements are not withdrawn, substantially clarification is required.

VI. Conclusion

For all of the foregoing reasons, it is respectfully submitted that the examiner has not made a *prima facie* case of obviousness, and the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application, including original claims 1-20 is therefore respectfully requested.

In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,



Russell E. Fowler II  
Attorney Registration No. 43,615

Please address correspondence to:

Harold C. Moore  
Maginot Moore & Beck  
Chase Tower  
111 Monument Circle, Suite 3250  
Indianapolis, Indiana 46204-5115

Telephone: (317) 638-2922  
Facsimile: (317) 638-2139  
Email: [hcmoore@maginot.com](mailto:hcmoore@maginot.com)